

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : James A. Parker Art Unit: : 2144
Serial No. : 09/915,719 Examiner: : Maniwang, Joseph R.
Filing Date : July 25, 2001
Title : Electronic Mail File Access System

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REASONS SUPPORTING

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

By accompanying papers, assignee appeals from the final Office Action dated January 30, 2007, and requests an extension of time and a pre-appeal-brief review.

The final Office Action ("FOA") allows some claims but rejects others as obvious. Specifically, claims 1-14 and 44-48 have been allowed and the balance rejected. All rejected claims have been rejected under 35 USC §103 for obviousness over Yamaguchi (U.S. Pub. 2002/00559382) in view of Kuzma (U.S. Patent 5,771,355). In addition, claims 26, 27, 53, and 54 have been rejected under 35 USC §101, and claims 53 and 54 have been rejected further under 35 USC §112(2).

Assignee identifies the following clear errors in the final Office Action, including omission of essential elements needed for a *prima facie* obviousness rejection.

I. ADDITIONAL CLAIMS ALLOWABLE FOR PARALLEL REASONS.

Claims 15, 16, 22, 25, 26, and 53 are allowable over the art for the same reasons as those given for allowance, namely, Yamaguchi does not disclose three distinct fields. Per the "statement of reasons for allowance," "claims 1 and 14 require the provision for an electronic message window including a first, second, and third field," with the first field being for e-mail message addresses, and the other two fields being for "authorized viewers" or "editors," respectively, but "Yamaguchi discloses a means for identifying addresses of one or more recipients of the message and designating each recipient as having viewing or editing privileges of the file, but *did not disclose* a first, second, and third field for generating authorization data used to authorize a requesting user for

viewing or modifying a file as claimed.” FOA, p. 7, ¶16 (emphasis added). The same distinction applies to independent claims 15, 16, 22, 25, 26, and 53 too:

Claims 16, 22: Both claims first refer to a “message recipient field,” then refer to “further includ[ing] a file viewer field and a file editor field.” The word “further” makes it apparent that the two latter fields are separate from the first field.

Claims 26, 53: Claim 26 specifies that the data stream contains data representing, separately, [1] “a message recipient frame,” [2] “a file editor frame,” and [3] “a file viewer frame.” See parts (b)-(d). Claim 53 likewise specifies that the data stream contains, separately, [1] “header data” identifying the “destination computer,” (part (a)), [2] “third frame” data identifying whether a destination computer will permit access for “display” of the attachment (part (d)), and [3] “fourth frame” data identifying whether a destination computer will permit access for “modification” thereof (part (e)).

Claim 25: This claim (part (a)) refers to a computer program that displays “a message window including a message recipient field,” then specifies (part (c)) that the program “includes, in the electronic message, indicia designating addresses entered into the message recipient field as ...” having certain characteristics. Because the claim specifies “indicia” designating characteristics of the contents of the “message recipient field,” the indicia cannot simply be that field’s contents.

Claim 15: This claim is presented in “means plus function” (35 USC §112(6)) format and includes a “means for identifying addresses of one or more recipients of the message and designating each recipient as having viewing or editing privileges of the file.” As stated in MPEP 2106 at pp. 2100-7 to -8 (8th ed. Rev. 5 Aug. 2006):

“Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and ‘equivalents thereof’ that correspond to the recited function. Two *en banc* decisions of the Federal Circuit have made clear that the USPTO is to interpret means plus function language according to 35 U.S.C. § 112, sixth paragraph. *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (*en banc*); *In re Alappat*, 33 F.3d 1526, 1540, 31 USPQ2d 1545, 1554 (Fed. Cir. 1994) (*en banc*).”

Here, the above-quoted “means” refers to means for accepting indicia into three separate fields, designating addresses and whether each intended recipient has viewing or

editing privileges, as shown in the specification. *See* Spec., Fig. 4 (indicia of viewing and editing privileges are the email addresses themselves, when entered into special fields 424, 426; *see esp.* ¶0078) & Fig. 5 (indicia of viewing and editing privileges are entered as “radio button” checks in fields 524, 526; *see esp.* ¶0083). Such a “means for accepting” *cannot* be simply code that allows accepting addresses into ordinary (to:, cc:, or bcc:) fields, as shown in Yamaguchi, which fields are defined to allow certain privileges, as that arrangement is neither disclosed in the present specification nor an equivalent.

In sum, the final Office Action did not identify any place where Yamaguchi purports to disclose the elements discussed above, namely “further” file viewer and editor fields or frames, designating message recipients as having viewing or editing privileges in separate parts of the email, or any “indicia” – included in the email – that designate whether any address entered into any “message recipient field” has viewing or editing privileges. (The Office Action argues only Yamaguchi, not the supporting Kuzma reference, for these claim elements.) Thus, there has been no showing of a *prima facie* rejection. To the contrary, the final Office Action concedes that the reference *lacks* the three separate fields, or fields plus indicia, as claimed. Claims 15, 16, 22, 25, 26, and 53 are distinct from the prior art for reasons parallel to those given to justify allowance of claims 1 and 14. The additional claims, and those dependent thereon, should be equally allowed (or at least, in the case of claims 26 and 53, the art rejection withdrawn).

II. ADDITIONAL CLAIM GROUP ALLOWABLE.

The final Office Action did not make a *prima facie* case of obviousness of independent claims 29 and 49 (and claims dependent thereon) because it did not address a key – repeatedly argued – distinction from prior art present in those claim.

Both claims state that, “based on the authorization status, for each address authorized for direct file access, transmitting data of the file separately from the electronic message, and for each address not authorized for direct file access, transmitting data of the file as an attachment to the electronic message.” The distinction relates to transferring the file associated with an email differently based on authorization status (such as might be indicated in viewer and editor fields, if present).

As the final Office Action concedes, “Yamaguchi did not specifically disclose for each electronic message sent to a file accessor address authorized for direct file access, transmitting data of the file separately from the electronic message.” [FOA, p. 5, 1st sentence] However, the Office Action purports to find the element missing from Yamaguchi in Kuzma, stating that Kuzma discloses sending attachment files by reference and thus separately from an email message. [*Id.*, ¶11]

But Kuzma does not disclose what is required by claim 29, part (c), quoted above (or claim 49, which has parallel language). Kuzma does not disclose transmitting data either separately or as an attachment, depending on DFA authorization status, as claimed.

Repeatedly, in writing and in interviews, assignee’s representative notified the examiner that the distinction had been overlooked. The examiner and SPE have provided no written reason for how either of the combined references (Yamaguchi or Kuzma) disclosed this feature or would have caused the ordinarily skilled artisan to have thought to incorporate this feature in the combination. Each time the point has been raised orally, the examiners have had nothing to say.

The Office owes assignee either an allowance of these claims or an explanation of how the cited references support a *prima facie* case of obviousness, including specific explanation as to the argued feature. See MPEP 707.07(f) (“Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it”).

III. CLAIMS AMENDED FROM “SIGNAL” FORMAT.

Two independent claims 26, 53 arose from a claim originally presented in “propagated signal” form but amended from that format in view of the Office’s revised guidelines, to avoid a dispute over any unsettled issues. As now configured, the claims cover apparatus comprising a transmission medium having a defined data stream.

The final Office Action (p. 3) argues that the claim body (as opposed to the preamble) contained only a data stream and the “transmission medium” could be intangible. Those arguments are clearly wrong and do not make a *prima facie* rejection:

First, the “transmission medium forming at least part of a computer network” is part of the claim’s body. The “medium” follows the word “comprising.”

Second, the “computer network” is obviously tangible.

Third, the “transmission medium” cannot be intangible. The Office has confused the medium with the message. A transmission medium – as opposed to electromagnetic (or other) signals that pass over a medium – is tangible. Tangible devices, such as optical fibers or wires, typically form transmission mediums. *See generally* Spec., ¶0047. Even wireless transmission relies on tangible equipment (such as transceivers and transmission towers, or satellites and links). The medium must form part of a “computer network,” providing further evidence of its tangible nature.

These claims are directed to a machine (or manufacture), which fully complies with the revised interim guidelines and is statutory. The Office has never provided any scholarly discussion of the revised guidelines or explanation of the Office’s reasons behind the rejection(except ones based on misunderstandings of the claims’ nature).

These claims parallel Beauregard claims, which are statutory. Beauregard claims consist of a signal (actually, software or “indicia of instructions”) residing on a “data storage medium.” The proposed claims, likewise, refer to signals (actually, a “data stream”) residing on a “transmission medium,” and they likewise should be patentable, provided that the transmission medium is tangible. The fact that the data stream is intangible does not matter because it is specified as being contained in (or passing through) a tangible transmission medium (part of a computer network).

Assignee and the undersigned thank the Office and respectfully request allowance. If further questions or issues arise, please call the undersigned.

Dated: May 10, 2007

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